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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,702	09/15/1999	ANOOP GUPTA	MSI-302US	7828

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EXAMINER

MOFIZ, APU M

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 08/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/396,702

Applicant(s)

GUPTA ET AL.

Examiner

Apu M Mofiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,12,13 and 28-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,12,13 and 28-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments filed August 01, 2003 with respect to claims 1-6,12-13 and 28-91 and the new limitations added by the applicant have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6,12-13 and 28-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Purnaveja et al. (U.S. Patent No. 6,006,241 and Purnaveja hereinafter), claims 1-18 of Purnaveja et al. (U.S. Patent No. 6,230,172 and Purnaveja hereinafter), claims 1-39 of Chaddha et al. (U.S. Patent No. 6,173,317 and Chaddha hereinafter), claims 1-25 of Gupta et al. (U.S. Patent No. 6,484,156 and Gupta hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the instant application are claiming common subject matter and they are substantially similar in scope and they use the same limitations, using varying terminology.

Claims 1-6,12-13 and 28-91 of the instant application corresponds to claims 1-18 of the 6,006,241 patent, claims 1-18 of 6,230,172 patent, claims 1-39 of 6,173,317 patent and claims 1-25 of 6,484,156 patent.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6,12-13 and 28-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabbe et al. ("Towards Intelligent Recognition of Multimedia Episodes in Real-Time Applications" 1994 ACM 0-89791-686-7/94/0010 and Gabbe hereinafter).

As to claims 1-6,12-13 and 28-91, Gabbe teaches receiving an indication of a plurality of annotations selected by a user, wherein each of the plurality of annotations corresponds to a media stream or to one or more media streams (i.e. the movie parser segments the video material into chunks of contextual information and also the system provides video recording, indexing, annotating, browsing tools and playback features; In

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this system the user may select a video image and annotate the image with text for subsequent use (i.e. the system allows the user to parse the seamless media stream into images and allows the user to index and annotate the images and also allows the user to playback the movie/seamless media stream with textual annotations)) (page 235, col 1-2); presenting a plurality of annotation identifiers (i.e. indexes) to the user; allowing the ordering of the plurality of annotation identifiers to be changed by the user (i.e. the system allows the user create indexes and hence change the ordering of images and annotations) (page 235, col 1-2); seamlessly providing one or more of , the plurality of annotations, and at least a portion of the media stream corresponding to each of the plurality of annotations; wherein seamlessly providing comprises seamlessly providing the one or more of the plurality of annotations and the portions of the media stream corresponding to each of the plurality of annotations in an order defined by the order of the plurality of annotation identifiers (page 235, col 1-2).

Points of Contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 3053830. The fax numbers for the group is (703) 746-7239.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Apu M. Mofiz
Patent Examiner
Art Unit 2175

August 20, 2003

DIANE B. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100